

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on February 17, 2004, the Examiner rejected claims 25-44 under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,317,718 to Fano ("Fano") in view of United States Patent No. 6,269,348 to Pare Jr. et al ("Pare"), United States Patent No. 6,199,753 to Tracy et al ("Tracy") and Robins, *Portable POS, 7 STORES 43-46* ("Robins"). The Examiner also rejected claims 25-44 under 35 U.S.C. 103 (a) as being unpatentable over United States Patent No. 6,587,835 to Treyz et al. ("Treyz") in view of Pare. Accordingly, Applicant respectfully provides the following:

Applicant respectfully submits that the claim set as provided herein is not made obvious by the cited references. The standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Applicant respectfully submits that there is no suggestion or motivation to continue the references cited by the Examiner, and that the references cited by the Examiner do not teach or suggest the limitations claimed in the present invention. In particular, independent claims 25, 28, 31 and 35 as provided herein include limitations

relating to automatically receiving product offers in a wireless purchasing device (WPD) via short range communication means, forwarding authorization information to a point of sale wireless vendor device short range communication means, initiating requests to an authorization processor via long range communication means, and receiving credit authorization by a long range communication at the WPD prior to the purchase of the product. The limitations as provide in the current claim set are supported by the disclosure as originally filed, and none of the references cited by the Examiner, alone or in combination, teaches or suggests such limitations.

The prior art does not suggest the combination of references cited against the present invention. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be "found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Indeed, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990); A "clear and particular" showing of the suggestion to combine is required to support an obviousness rejection under Section 103. MPEP § 2142. In essence, the Applicant urges that the combination of the listed references is not a product of a suggestion contained within them, but a product of inappropriate hindsight analysis. "Hindsight reconstruction" cannot be used "to pick and choose among isolated disclosures in the prior art to deprecate the claimed

invention." *Ecolochem, Inc. v. S. California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000) (quoting *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Rather, "the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." *Id.* For the reasons set forth below, Applicant submits that the prior art fails to clearly and particularly suggest the combination indicated by the Examiner. Thus, Applicant's claims are not obvious in view of the prior art references.

First, the references cited against the present invention do not contain an express suggestion to combine. Further, it would not be obvious to one of ordinary skill in the art to combine the teachings of Fano with Pare, Tracey and Robins. Fano and Tracey teach portable systems, used by a purchaser, which provide customized information to consumers. Pare and Robins teach electronic transaction devices, utilized by vendors. There is no suggestion or motivation expressed or implied in the art to combine the teachings of Robins and Pare, which teach vendor devices with the teachings of Fano and Tracey, which teach portable devices held by customers to display tailored shopping advertisements. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-the essence of hindsight." *Id.* (quoting *In re Dembicza*k, 175 F.3d 994 (Fed. Cir. 1999)).

Further, it would not be obvious to one of ordinary skill in the art to combine Treyz with Pare and Robins. Treyz teaches a portable device utilized by customers while Pare and Robins disclose devices used by vendors for completing transactions. In

light of the absence of any suggestion or motivation to combine the above-referenced prior art, the mere fact that such prior art could combine in the manner suggested by the Examiner does not render the present invention obvious. M.P.E.P. 2142. Moreover, in this case the combined references fail to produce or suggest each limitation of the claimed invention.

To establish prime facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art. *In Re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Applicant respectfully submits that the references cited by the Examiner do not teach or suggest the limitations claimed in the present invention.

Generally, please note that in the present invention the purchaser sends an electronic funds request to an authorization device, whereas prior art invention teach that the vendor device performs a conventional electronic fund request. There are at least two specific advantages in the purchaser sending the fund request to the authorization processor. First, vendors do not have to be in possession of a machine capable of sending the electronic fund request to process the transaction; second, the present invention provides added security to the purchaser.

First, vendors do not have to be in possession of a machine capable of performing electronic fund requests. Instead, the purchaser carries a machine capable of performing the electronic fund request. This shift provides several advantages. An example of such an advantage can be found in the case of a soda machine. The owner of a soda machine typically does not have the capacity to, nor the economic interest in, equipping the soda machine with a device capable of performing a conventional

electronic fund request. In such a case, the present invention provides the advantage that the purchaser is capable of transacting the purchase directly with the authorization processor because the purchaser is in possession of technology that allows the purchaser to conduct the electronic funds request. That is, the purchaser has the capacity to contact a credit company directly.

Second, the terms of the present invention provide added security to the purchaser because the authorization occurs between the purchaser and the credit company, not the vendor and the credit company. In the conventional electronic request transaction the purchaser surrenders possession of the privacy of their credit portfolio to the vendor who then sends or transmits that data to a credit card company (e.g., *Visa®*). Because the purchaser surrenders this information to the vendor, the purchaser is no longer capable of being assured that the information is technologically protected (e.g., identity theft issues). The present invention allows the purchaser to maintain their credit information in a secure environment. For example, the purchaser can maintain their credit information in a PDA, which operates only when in contact with the thumbprint of the purchaser. The purchaser then contacts the credit company directly. Because this transaction obviates the need for an intermediary, the vendor, the present invention provides significant security advantages over the conventional electronic funds request.

Fano fails to disclose several elements of the present invention. The Examiner relies on Fano as a primary reference to disclose the claim limitations of the present invention, and utilizes Pare, Tracey and Robins to supplement Fano's disclosure. Fano

does not disclose forwarding authorization information to a point of sale wireless vendor via a short-range communication device. Fano does not disclose a long-range communication device for initiating a request to an authorization processor, and Fano does not disclose receiving a response from an authorization processor via a long-range communication device. Thus, the Examiner relies on Pare, Tracey and Robins to supplement the disclosure found in Fano.

The Examiner relies on Fano to disclose forwarding authorization information to a point of sale wireless vendor device via short-range communication device. Fano does not disclose a device held by the customer, which initiates and receives authorization information from a credit agency. Fano simply teaches a device utilized by customers, which receives customized shopping advertisements based upon the customer's geographic position. Further, none of the art cited by the Examiner discloses a method wherein the consumer receives sale information and forwards authorization information from a credit agency to a point of sale wireless vendor device.

The Examiner relies on Pare to disclose a long-range communication device for initiating a request to an authorization processor and receiving a response from the authorization processor. Pare discloses a device utilized by a vendor, which contacts a data processing center. The present invention teaches a device utilized by the customer, wherein the customer contacts the data processing center. The independent claims of the present invention include the claim limitation "an apparatus for use by a purchaser ... comprising ... a long range communications device ... for initiating a request to an

authorization processor and receiving a response from the authorization processor for the authorization of a purchase.” Pare does not disclose a device utilized by the purchaser, which initiates and receives authorization for purchase. Instead Pare teaches a vendor device, which initiates and receives authorization for a purchase. Thus, Pare teaches a way of providing security, via biometric means, without the use of manmade tokens (e.g. credit card) for completing transactions, not “an apparatus for use by a purchaser … for initiating a request… and receiving a response from the authorization processor”

The Examiner notes that all of the references are silent regarding the preauthorization from the financial institution before the purchase of an item, and cites Robins to teach that a portable device is not limited to the space inside four walls. However, Robins does not disclose a device used by a purchaser. Robins merely discloses a vendor device used outside of the store. Thus instead of the vendor device inside stores such as Mervyns, Robins discloses the use of a vendor device utilized just outside the doors of stores such as Mervyns. Consequently, the prior art cited by the Examiner fails to disclose the step of the customer's device utilizing long range communication for initiating and receiving authorization information for a purchase.

The Examiner indicates that the claims of the present invention are unpatentable over Treyz in view of Pare and Robins. As previously mentioned, there is no suggestion to combine Treyz, Pare and Robins. Additionally, Applicant respectfully submits that the combination of Treyz and Pare fails to teach or suggest the claim limitations of the present invention.

The Examiner indicates that Treyz does not disclose a transaction system, which allows the purchaser to request authorization for the purchase, and that Treyz is silent regarding receiving preauthorization from a financial institution for the purchase of the item. Further, Applicant respectfully suggests that Treyz fails to disclose forwarding said authorization information to a point of sale wireless vendor device via short range communication device. The Examiner relies on Pare and Robins to disclose these elements of the presently claim invention. As indicated above Pare fails to disclose "a long range communications device... for initiating a request ... and receiving response from the authorization processor for authorization of a purchase." Likewise, Robins fails to disclose a device utilized by a purchaser, which comprises a long-range communication device utilized for initiating and receiving authorization for a purchase. Both Pare and Robins instead disclose devices utilized by vendors, which directly contact financial institutions, and directly receive to the vendor, authorization or preauthorization for the purchase of an item.

Accordingly, Applicant respectfully submits that for at least the reasons provided herein, the references cited by the Examiner, alone or in combination, do not teach or suggest all the claim limitations of the independent claims. And, since the references cited by the Examiner do not teach or suggest each and every limitation of the independent claims, Applicant respectfully submits that the prior art references do not make obvious independent claims 25, 28, 31 and 35 as provided herein. Further, since the prior art references do not make obvious independent claims 25, 28, 31 and 35, Applicant respectfully submits that the prior art references cited by the Examiner do not

make obvious the corresponding dependent claims 26-27, 29-30, 32-34, 36-44, which depend from independent claims 25, 28, 31 and 35.

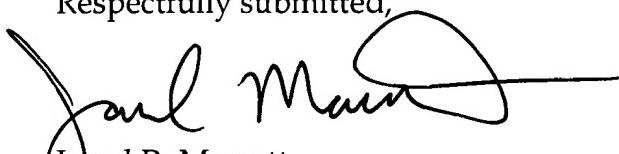
Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 24 day of December 2004.

Respectfully submitted,



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